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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,651	06/26/2001	Hans-Heinrich Muller	31512-172587	9122

26694 7590 12/26/2002

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EXAMINER

WALLS, DIONNE A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 12/26/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-9

Office Action Summary	Application No.	Applicant(s)	
	09/888,651	MULLER ET AL.	
	Examiner	Art Unit	
	Dionne A. Walls	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on October 3rd, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "a steel paneling which is coated with tungsten carbide/cobalt".

The Examiner notes that Applicant has asserted that the language added to the specification corrects a translation error from the priority document which, as stated on the first page of the specification, is incorporated into the written specification by reference. However, unless Applicant provides a certified copy of the English translation of said document verifying the content of the priority document (and, hence, the amended language), the Examiner will assume the added language is new matter, and request that Applicant cancel such language in the reply to this Office Action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 9-10 and 15 are rejected under 35 U.S.C. 103 as being unpatentable over Applicant's Admitted Prior Art in view of Runkle (US. Pat. No. 5,290,507).

Applicant has admitted that known, modern cigarette-making machines comprise a conveyor which includes a duct defining an elongated path arranged to receive a continuous shower of tobacco particles (corresponding to the claimed "flowable particulate material"), said particles being converted into an elongated stream by a stretch of an endless foraminous belt to which the particles are attracted to the underside. The underside of said belt constitutes one wall of the duct, and the duct includes stationary additional walls serving to flank the sides of the path beneath the lower reach of the belt and being in continuous contact (corresponding to the claimed "direct contact") with the moving tobacco particles. Applicant then states that attempts to ensure that the stationary walls of the duct will offer low resistance to sliding movement have included adding a coating of such walls with a steel paneling which is coated with tungsten carbide/cobalt, which also provides adequate resistance to wear. While Applicant's admitted art may not state that the walls are coated with a ceramic material, Runkle states that carbide compositions, such as tungsten carbide (a ceramic) or the cemented tungsten carbide cobalt (a cermet) have outstanding wear resistance (i.e. to abrasion, corrosions and wear). (col. 1, lines 39-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to substitute the tungsten carbide cobalt with tungsten carbide, which is a ceramic material, since this material is well-known for its wear resistance.

Regarding claim 6, Applicant's Admitted Art modified by Runkle may not specifically articulate that the lining has a thickness in the range of between .05-.5 mm; however, it would have been obvious to one having ordinary skill in the art at the time of the invention to arrive at the claimed thickness ranges for the ceramic lining of the side-guides in an effort to optimize the efficiency of wear-resistance while minimizing material costs.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Runkle (US. Pat. No. 5,290,507), and further in view of GB 885,485.

While Applicant's Admitted Prior Art modified by Runkle (US. Pat. No. 5,290,507) may not state that the surface adjacent the path has a consistency resembling that of the surface of an orange peel, GB 885,485 states that machine parts, made of metal, are often *sprayed* with ceramic material, in order to impart hardness and wear resistance, resulting in an abrasive surface (see page 1). This would suggest to one having ordinary skill in the art that the surface of the ceramic material would not be smooth and may have some irregularities/roughness (corresponding to the claimed "orange peel surface") that, based on the parameters of the operating system, could be adjusted or finished to ensure efficient wear resistance.

5. Claims 1-5,7, 9-11, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 197 33 443 in view of Applicant's Admitted Prior Art and Runkle (US. Pat. No. 5,290,507).

DE 197 33 443 discloses a guide 1 (corresponding to the claimed "conveyor") for advancing a stream of tobacco particles (corresponding to the claimed "flowable particulate material"), comprising channel 7 (corresponding to the claimed "duct") defining a path for the tobacco particles and having sidewalls 14,16 flanking the channel, along with the lower stretch of foraminous belt 6 and inserts 4 which have marginal portions (corresponding to the claimed "two additional walls") (see figs; Note: U.S. equivalent 6,186,315). While DE 197 33 443 may not articulate that at least one of said walls consists at least in part of a ceramic material, Applicant has admitted that it is known to coat these walls with a steel paneling which is coated with tungsten carbide/cobalt – which provides adequate resistance to wear. While Applicant's admitted art may not state that the walls are coated with a ceramic material, Runkle states that carbide compositions, such as tungsten carbide (a ceramic) or the cemented tungsten carbide cobalt (a cermet) have outstanding wear resistance (i.e. to abrasion, corrosions and wear). (col. 1, lines 39-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to substitute the tungsten carbide cobalt with tungsten carbide, which is a ceramic material, since this material is well-known for its wear resistance.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of DE 197 33 443 to include a tungsten carbide coating on the walls in order to offer low resistance to the sliding movement of the tobacco particles that flow by said walls as taught by Applicant on page 5 of the instant specification.

Regarding claim 7, while there may be no clear articulation as to whether the ceramic lining of DE 197 33 443 modified by Applicant's Admitted Prior Art is applied during its molten state or by spraying, this limitation is not deemed to impart any patentable weight to the claims since it articulates a *method* limitation (i.e. the manner in which ceramic is applied), not a *structural* limitation, when the claims are drawn to an apparatus. Apparatus claims must be *structurally* distinguishable from the prior art. See MPEP 2114.

Allowable Subject Matter

6. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. Claim 16 is allowed.

Response to Arguments

8. Applicant's arguments filed on October 3rd, 2002 have been fully considered but they are not persuasive.

- Applicant asserts that its Admitted prior art, which has been amended to reflect a translation error, now indicates that "the walls of are lined with a tungsten carbide/cobalt material", and that this material is not a ceramic material. This argument is moot based on new grounds for rejection necessitated by the amendment to the specification. (Note the "new matter" objection to the specification in paragraph 1).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

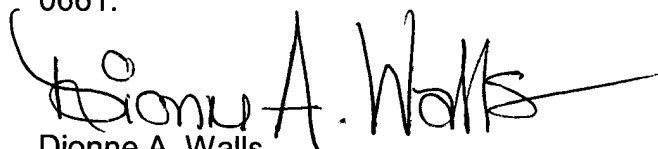
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-

0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Dionne A. Walls
December 19, 2002

A handwritten signature in black ink, appearing to read "Steven P. Griffin". The signature is cursive and compact, with a small loop at the end.

STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700